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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,523

12/23/2003

Honjung Lee

118109

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25944 7590 03/29/2007  
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EXAMINER

RAE, CHARLESWORTH E

ART UNIT

PAPER NUMBER

1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

03/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/743,523

Applicant(s)

LEE ET AL.

Examiner

Charlesworth Rae

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-88 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Status of the Claims***

Claims 1-88 are currently pending and are the subject of this Office Action.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, 7-17, 19-31, 34-42, 44-54, 56-68, 71, 72, 73, 84, and 87-88 drawn to a composition of foundation type comprising at least one coloring agent and reflective particles, classified as class 424, and subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.
- II. Claims 1, 6, 43, drawn to a composition of foundation type comprising a sole coloring agent, classified as class 424, subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.
- III. Claims 1, 32, 33, 69, 70, drawn to a composition of foundation type comprising additional optional ingredient(s), classified as class 424, and subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.
- IV. Claims 1, 18, 55, drawn to a composition of foundation type wherein at least one coloring agent is surface-treated, classified as class 424, subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.

- V. Claim 74-75, 79-86, drawn to a method for making up dark skin, classified as class 424, subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.
- VI. Claims 76-78, drawn to a kit, classified as class 424, subclass 70.6+. If this group is elected, then the below Summarized Species Election is also required.

Inventions I-IV are directed to related compositions. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are distinct because the inventions are either not capable of use together or can have a materially different design, mode of operation, function in view of their divergent subject matter. Specifically, Invention I is drawn to a composition comprising at least one coloring agent and reflective particles, wherein the coloring agent is not surface-treated; Invention II is directed towards to a composition comprising a sole coloring agent; Invention III is directed to a composition comprising additional optional ingredients; Invention IV is directed to a composition comprising at least one coloring agent that is surface-treated. These different compositions encompass different active ingredients that possess different characteristics which would reasonably confer different treatment effects. Inventions I-IV, and V, and VI are related to the extent that inventions V and VI encompass the compositions of inventions I-IV. Inventions I-IV, and

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invention V, and Invention VI, are distinct or independent as these inventions are directed towards different statutory inventions. To the extent that the generic inventions encompass a multiplicity of active ingredients and subcompositions, there would be a serious search burden created if the inventions were searched together.

Because these inventions are independent or distinct for the reasons given above, and there would be a serious burden on the examiner if restriction is not required, restriction for examination purposes as indicated is proper.

***Election of Species regarding Groups I-VI***

This application contains claims directed to more than one species of the generic Inventions that would require an unduly extensive and burdensome search by the examiner if all the claimed species were examined together.

For example, inventions I-VI encompass multiple species of subcompositions comprising different coloring agents/different types of reflective particles and different amounts of the same coloring agents/reflective particles, and different formulations. These subcompositions would reasonably confer different treatment effects in view of the different active ingredients and different amount of active ingredients contained therein.

Applicant is required to elect one single foundation type composition for examination purposes, wherein each individual ingredient and the amount of the ingredients are specifically indicated.

For example, a single coloring agent e.g. brown dye

For example a single reflective particle e.g.  $\text{Fe}_2\text{O}_3$

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For example a single additional optional ingredient e.g. a single specifically disclosed filler, or a single specifically disclosed film-forming polymer.

For example, a single specific formulation e.g. liquid, or paste, or solid.

These species are independent or distinct because they represent different chemical compositions that would reasonably exhibit different treatment effects. In view of the multiple different active ingredients encompassed by the instant claims, and undue search burden would be created if these different compositions were searched together.

***Additional Election of Species regarding Groups V***

Also, inventions V encompass multiple species of different methods for treating dark skin which would reasonably exhibit different effects e.g. method directed to treat a dark skin would reasonably exhibit a different effect from a method directed towards lightening dark skin. To the extent that these different treatment methods confer different effects, they are distinct. In view of the multiple compositions encompassed by the generic claim, a serious search burden would be created if these different methods of treatment were searched together. Thus, the election requirement is deemed to be proper. If applicant elects group V, then applicant is further required to elect a) a method for making up dark skin, or b) a method for lightening dark skin for examination purposes.

Applicant is required to elect one exact foundation type composition for examination purposes wherein the each active ingredient(s), and amounts of the individual ingredients are specifically indicated.

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Under 35 U.S.C. 121, applicant is required to elect a single disclosed composition/subcomposition for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 37, 74, 75, 76, 79, 81, 82, 83, and 85 are considered generic to the above listed species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

#### ***Inventorship Notice***

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are

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subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

24 March 2007  
CER

ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER

*Ardin H. Marschel* 3/23/07  
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